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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/648,486	08/28/2000	Hidehisa Shitomi	ASA-926	5771

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EXAMINER

CHANG, SABRINA A

ART UNIT	PAPER NUMBER
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3625

DATE MAILED: 01/17/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/648,486

Applicant(s)

SHITOMI ET AL.

Examiner

Sabrina Chang

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 28 August 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 August 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Specification***

The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 5, 8, 11, and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by Ananda U.S. Patent No 5,548,645.

Ananda discloses a system for providing secure access and execution of application software. A consumer can access a second computer/system, or server, that contains rental application software by logging in, using a password [Col 3, Line 10]. The password, customer ID and customer information is stored in a database [fig. 2, Element 212]. The consumer can select a specific application from the rental application software database according to his/her own specifications [Col 3, Lin 40]. The software is then encrypted and sent to the user [Col 2, Line 67] for use only as specified by the provider.

### ***Claim Rejections - 35 USC § 103***

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The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ananda U.S. Patent No 5,548,645, as rejected in claim 1, in view of Official Notice regarding database.

Ananda does not explicitly disclose that the user requirements include a charge limitation. Examiner takes official notice however that searching by or limiting database fields, in the instant case “pricing”, is notoriously known in the art of database management. It would have been obvious to modify the system of Ananda, which includes a database of application software items and related information, to allow the customer to search for a particular application software based upon price or any field, as taught by official notice, to make it easier and more efficient for him/her to find appropriate/relevant products.

Claims 3, 4, 6, 7, 9, and 10, are rejected under 35 U.S.C. 103(a) as being unpatentable over Ananda U.S. Patent No 5,548,645, as rejected in claim 1, in view of Kanno U.S. Patent no. 5,943,650.

In specific reference to claims 4, 7, and 10, Ananda does not explicitly disclose concentrating a counter of services for a plurality of applications.

Kanno discloses an operation management system for limiting customer use of a software product. The software products can include application software programs such as CAD, games, video, language processors, music, communication, measurement, etc [Col 2, Line 63]. A customer is given a “battery value” which drives a managed software product. This battery value

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is preferably the value of a counter [Col 2, Line 49]. As the customer “rents” a software package, the “battery value” is decreased [Col 3, Line 50]. If the specifications of the application software product do not satisfy the user’s request, the user does not purchase it [Col 3, Line 35].

In that Ananda already includes a database that stores customer information for authentication, it would have been obvious to modify the system to include counter/charging limitations, as taught by Kanno, in order to monitor/manage customer usage of resources.

In specific reference to claims 3, 6, and 9, the system of Ananda/Kanno does not explicitly provide that a user can exchange an application not satisfying the user requirements. However in that Kanno does allow the user to not purchase a particular software program, it would have been obvious to modify the system of Ananda/Kanno to allow the user to exchange for a more suitable package in order to ensure customer satisfaction.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Benson U.S. Patent No. 6,334,118 discloses a software rental system and method.

Herman et al. U.S. Patent No. 6,341,353 discloses a system of tracking purchases of application software. It does not explicitly disclose the method by which these purchases were made.

Jia U.S. Patent No. 5,991,402 discloses a method and system that enables software-on-demand. It does not explicitly disclose the specifics of the selection and purchase of particular programs.

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“searchWebservices.com Definitions – Application service provider” discloses a general description of application service provider. It does not explicitly disclose the specifics of

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sabrina Chang whose telephone number is 703 305 4879. The examiner can normally be reached on 8:30 am - 5:30 pm Mon.- Fri..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins can be reached on 703 308 1344. The fax phone numbers for the organization where this application or proceeding is assigned are 703 305 7687 for regular communications and 703 305 7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 308 1113.

SC  
January 13, 2003

*[Handwritten signature]*